



1-18-05

AF *[Signature]*

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/030,332	Art Unit:	1625
Filed:	February 15, 2002	Examiner:	C. Chang
1 <sup>st</sup> Inventor:	Y. Ishihara	Allowed:	
For:	Cyclic Amide Compounds, Process for the Preparation of the Same and Uses Thereof	Batch:	
Atty. Dkt. No.	2599 US0P	Paper No.:	

**RESPONSE D**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action mailed September 16, 2004, Applicants respectfully request reconsideration of the claims in view of the amendment and remarks set forth below. A Request to Withdraw Finality, a Petition for a One-Month Extension of Time and authorization to pay the \$ 120.00 37 CFR Sec. 1.17(a)(1) fee accompany this response.

**AMENDMENT****In the Specification**

Please enter the following modifications to the specification.



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**REQUEST FOR WITHDRAWAL OF PREMATURE FINAL REJECTION**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request reconsideration of the finality of the rejection in the Office Action dated September 16, 2004. Applicants believe that the finality of the rejection was premature, as their submission of June 18, 2004 modified claims and presented new arguments which the Examiner neither acknowledged nor considered.

In the Advisory Action dated April 19, 2004, the Examiner stated that Applicants' communication of February 20, 2004 could not be entered because the proposed amendment raised new issues that would require further consideration and/or search. Applicants infer that the Examiner made this determination due to the further limitation of E as a trimethylene group in the claims in the February 20, 2004 communication.

Accordingly, Applicants filed a Request for Continued Examination along with Response C on June 18, 2004 wherein the unentered amendments to the claims were repeated. Furthermore, Response C provided a new argument for the non-obviousness of independent claim 1 over the cited art of Kato *et al.* on page 25; and a new argument for the non-obviousness of independent claim 1 over Kim *et al.* in view of Caldwell *et al.* on page 26. The Examiner did not provide reasons why the amended claims wherein the compounds having E = trimethylene

were still unpatentable; nor respond to the arguments made on pages 25 and 26 in the Final Office Action dated September 16, 2004.

According to the MPEP Sec. 706.07(b), "it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised." Applicants assert that not only would the present circumstances fall under alternative (A) above, but also that finality is improper because new arguments were presented in Response C.

Therefore, Applicants respectfully request reconsideration and withdrawal of the finality of the rejection as premature. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, she is respectfully invited to call Applicants' attorney at the number below.

Respectfully submitted,

Dated: January 14, 2005

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Lincolnshire, IL 60069 USA

#### **Certificate of Mailing under 37 CFR 1.10**

The undersigned hereby certifies that this document, along with any attachments, is being deposited in an envelope addressed to The Commissioner of Patents and Trademarks, with sufficient postage with the United States Postal Service EXPRESS MAIL Post Office to Addressee Service on this date January 14, 2005.

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*Gail L. Winokur*  
Printed Name: Gail L. Winokur